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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/647,528

08/26/2003

Ryoji Watanabe

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05/14/2008

OLIFF & BERRIDGE, PLC

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EXAMINER

PAN, JOSEPH T

ART UNIT

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2135

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/647,528	Applicant(s) WATANABE ET AL.	
	Examiner JOSEPH PAN	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/14/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 22, 2008 has been entered.

2. Applicant's response filed on January 22, 2008 has been carefully considered. Claims 1, 9, 10, 11, 13, and 14 have been amended. Claims 1-14 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakagawa (U.S. Patent No. 6,931,541 B1) in view of Bozeman (U.S. Patent No. 6,754,640 B2).

Referring to claim 1:

i. Nakagawa teaches:
an image forming system comprising:
an image display medium, that is a sheet of paper, on which a first image is displayed (see column 7, lines 63-67 'Note that the present invention may be applied to either a system constituted by a plurality of equipments (e.g., a host computer, an interface device, a reader,

a printer, and the like), or an apparatus consisting of a single equipment (e.g., a copying machine, a facsimile apparatus, or the like).’, of Nakagawa, emphasis added); and

an image forming apparatus (see figure 1, element 30 ‘scene synthesization circuit’ of Nakagawa), wherein:

the image display medium includes a data supply apparatus, which stores therein data of a second image and authentication data used for an access authentication to the data of the second image and supplies the stored data of the second image and the stored authentication data to an external (see column 5, lines 34-43 of Nakagawa); and

the image forming apparatus includes:

an image reading section for reading the displayed first image (see column 7, lines 63-67; and figure 1, element 17 ‘motion image decoding circuit’ of Nakagawa);

a data reading section for reading the supplied data of the second image and the supplied authentication data (see column 7, lines 63-67; and figure 1, element 17 ‘motion image decoding circuit’ of Nakagawa);

an image forming section for forming the first image and the second image when the access to the data of the second image is authenticated, and for forming the first image when authentication fails (see column 5, lines 34-43 of Nakagawa).

Nakagawa discloses that the invention may be applied to “an apparatus consisting of a single equipment (e.g., a copying machine, a facsimile apparatus or the like” (see column 7, lines 63-67 of Nakagawa). However, Nakagawa does not explicitly mention that the image display medium is a sheet of paper.

ii. Bozeman teaches a universal positive pay match, authentication, authorization, clearing, and settlement system to reduce check and card fraud, wherein Bozeman discloses that the image display medium is a sheet of paper (see column 3, lines 34-37 “It is a further object of the invention to utilize a check with a micro computer chip [i.e., the data supply apparatus] embedded within the paper surface of the check [i.e., a sheet of paper], to contain digitized signatures, security, GPS locate and check registration information.”, of Bozeman, emphasis added).

iii. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Bozeman into the method of Nakagawa to use a sheet of paper as an image display medium for a copying machine.

iv. The ordinary skilled person would have been motivated to have applied the teaching of Bozeman into the system of Nakagawa to use a sheet of paper as an image display medium for a copying machine, because Nakagawa discloses that the invention may be applied to “an apparatus consisting of a single equipment (e.g., **a copying machine, a facsimile apparatus** or the like”, and it’s well known that a sheet of paper is used as an image display medium for a copying machine, a facsimile apparatus or the like.

Referring to claim 9:

i. Nakagawa teaches:

An image display medium to display images, comprising:

A first image displayed on a surface of the image display medium, wherein the image display medium is a sheet of paper (see column 7, lines 63-67 ‘Note that the present invention may be applied to either a system constituted by a plurality of equipments (e.g., a host computer, an interface device, a reader, a printer, and the like), or an apparatus consisting of a single equipment (e.g., **a copying machine, a facsimile apparatus**, or the like).’, of Nakagawa, emphasis added); and

a data supply apparatus for storing data of a second image and supplying the stored data of the second image and the stored authentication data to an external (see figure 3; and column 5, lines 34-43 of Nakagawa).

Nakagawa discloses that the invention may be applied to “an apparatus consisting of a single equipment (e.g., **a copying machine, a facsimile apparatus** or the like” (see column 7, lines 63-67 of Nakagawa). However, Nakagawa does not expressly mention that the image display medium is a sheet of paper.

ii. Bozeman teaches a universal positive pay match, authentication, authorization, clearing, and settlement system to reduce check and card fraud, wherein Bozeman discloses that the image display medium is a sheet of paper (see column 3, lines 34-37 “It is a further object of the invention to utilize a check with a micro computer chip [i.e., the data supply apparatus] embedded within the paper surface of the check [i.e., a sheet of paper], to contain digitized signatures, security, GPS locate and check registration information.”, of Bozeman, emphasis added).

iii. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Bozeman into the method of Nakagawa to use a sheet of paper as an image display medium for a copying machine.

iv. The ordinary skilled person would have been motivated to have applied the teaching of Bozeman into the system of Nakagawa to use a sheet of paper as an image display medium for a copying machine, because Nakagawa discloses that the invention may be applied to “an apparatus consisting of a single equipment (e.g., **a copying machine, a facsimile apparatus** or the like”, and it’s well known that a sheet of paper is used as an image display medium for a copying machine, a facsimile apparatus or the like.

Referring to claim 11:

i. Nakagawa teaches:

An image forming apparatus comprising:

an image reading section for reading a first image of a image display medium, wherein the image display medium is a sheet of paper (see column 7, lines 63-67 ‘Note that the present invention may be applied to either a system constituted by a plurality of equipments (e.g., a host computer, an interface device, a reader, a printer, and the like), or an apparatus consisting of a single equipment (e.g., **a copying machine, a facsimile apparatus**, or the like).’, of Nakagawa, emphasis added);

a data reading section for reading data of a second image and authentication data from the image display member (see figure 3; and column 5, lines 34-43 of Nakagawa);

an authentication section for receiving access to the data of the second image and determining whether or not allowing the access to the data of the second image on the basis of the read authentication data (see figure 3; and column 5, lines 34-43 of Nakagawa); and

an image forming section for forming the first image and the second image when the access to the data of the second image is authenticated, and for forming the first image in other cases (see figure 3; and column 5, lines 34-43 of Nakagawa).

Nakagawa discloses that the invention may be applied to “an apparatus consisting of a single equipment (e.g., **a copying machine, a facsimile apparatus** or the like” (see column 7, lines 63-67 of Nakagawa). However, Nakagawa does not expressly mention that the image display medium is a sheet of paper.

ii. Bozeman teaches a universal positive pay match, authentication, authorization, clearing, and settlement system to reduce check and card fraud, wherein Bozeman discloses that the image display medium is a sheet of paper (see column 3, lines 34-37 “It is a further object of the invention to utilize a check with a micro computer chip [i.e., the data supply apparatus] embedded within the paper surface of the check [i.e., a sheet of paper], to contain digitized signatures, security, GPS locate and check registration information.”, of Bozeman, emphasis added).

iii. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Bozeman into the method of Nakagawa to use a sheet of paper as an image display medium for a copying machine.

iv. The ordinary skilled person would have been motivated to have applied the teaching of Bozeman into the system of Nakagawa to use a sheet of paper as an image display medium for a copying machine, because Nakagawa discloses that the invention may be applied to “an apparatus consisting of a single equipment (e.g., **a copying machine, a facsimile apparatus** or the like”, and it’s well known that a sheet of paper is used as an image display medium for a copying machine, a facsimile apparatus or the like.

Referring to claims 13-14:

i. Nakagawa teaches:

An image forming method comprising:

supplying data of a second image and authentication (see figure 3; and column 5, lines 34-43 of Nakagawa);

reading a first image from the image display medium (see figure 3; and column 5, lines 34-43 of Nakagawa);

reading the supplied data of the second image and the supplied authentication data from the image display medium (see figure 3; and column 5, lines 34-43 of Nakagawa);

receiving access to the data of the second image (see figure 3; and column 5, lines 34-43 of Nakagawa);

determining whether or not the second image is authenticated based on the read authentication data and the received access data (see figure 3; and column 5, lines 34-43 of Nakagawa); and

forming the first image and the second image when access to the data of the second image is authenticated, and forming only the first image in the other cases (see figure 3; and column 5, lines 34-43 of Nakagawa).

Nakagawa discloses that the invention may be applied to “an apparatus consisting of a single equipment (e.g., **a copying machine, a facsimile apparatus** or the like” (see column 7, lines 63-67 of Nakagawa). However, Nakagawa does not expressly mention that the image display medium is a sheet of paper.

ii. Bozeman teaches a universal positive pay match, authentication, authorization, clearing, and settlement system to reduce check and card fraud, wherein Bozeman discloses that the image display medium is a sheet of paper (see column 3, lines 34-37 “It is a further object of the invention to utilize a check with a micro computer chip [i.e., the data supply apparatus] embedded within the paper surface of the check [i.e., a sheet of paper], to contain digitized signatures, security, GPS locate and check registration information.”, of Bozeman, emphasis added).

iii. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Bozeman into the method of Nakagawa to use a sheet of paper as an image display medium for a copying machine.

iv. The ordinary skilled person would have been motivated to have applied the teaching of Bozeman into the system of Nakagawa to use a sheet of paper as an image display medium for a copying machine, because Nakagawa discloses that the invention may be applied to “an apparatus consisting of a single equipment (e.g., **a copying machine, a facsimile apparatus** or the like”, and it’s well known that a sheet of paper is used as an image display medium for a copying machine, a facsimile apparatus or the like.

Referring to claims 2-3, 10, 12:

Nakawaga and Boseman teach the claimed subject matter: an image forming system (see claim 1 above). They further disclose the encryption and the decryption (see column 2, lines 47-50 of Nakagawa).

Referring to claims 4-5:

Nakawaga and Bozeman teach the claimed subject matter: an image forming system (see claim 1 above). They further disclose the authentication (see column 2, lines 47-50 of Nakagawa).

Referring to claim 6:

Nakawaga and Bozeman teach the claimed subject matter: an image forming system (see claim 1 above). They further disclose the data supply apparatus is a non-contact memory (see column 3, lines 34-37 of Bozeman).

Referring to claim 7:

Nakawaga and Bozeman teach the claimed subject matter: an image forming system (see claim 1 above). They further disclose password (see column 8, lines 6-15 of Bozeman).

Referring to claim 8:

Nakawaga and Bozeman teach the claimed subject matter: an image forming system (see claim 1 above). They further disclose the image forming section forms the second image in combination with the first image (see figure 3; and column 3, lines 34-43 of Nakagawa).

Response to Arguments

5. Applicant's arguments, filed on January 22, 2008, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Bozeman.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Pan whose telephone number is 571-272-5987.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached at 571-272-3859. The fax and phone numbers for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

Joseph Pan

May 7, 2008

/KIMYEN VU/

Supervisory Patent Examiner, Art Unit 2135